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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,804	09/24/2001	Mari Kurosawa	SHI-015-USA-	8914

7590

06/06/2002

Law Offices of Townsend & Banta
Suite 500
1225 Eye Street NW
Washington, DC 20005

EXAMINER

BERMAN, ALYSIA

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 06/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,804

Applicant(s)

KUROSAWA ET AL.

Examiner

Alysia Berman

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of first layer foundation composition (3) in Paper No. 6 and the polyether modified silicone described in the response filed April 8, 2002, paper no. 8, is acknowledged.
2. Claims 1-4 are pending and have been examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.
4. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The claims are indefinite because it is unclear if Applicant intends to claim a kit containing two discrete compositions or a composition containing both compositions combined together. What is a two-layer makeup cosmetic composition? Is this a composition that exists as two layers within one container, a single composition that provides two layers when applied or a kit containing one composition that is layered on another composition when applied?
6. The term "minimized" in claims 1-4 is a relative term which renders the claims indefinite. The term "minimized" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

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7. The claims are indefinite because claim 1 contains brackets and parentheses. It is unclear if the limitations in the brackets and parentheses are required by the claim.

8. The claims are indefinite because claim 1 contains colons after "the first layer foundation composition" at line 6 and after "the second layer finishing composition" at line 26. It is unclear if the first and second layer compositions can contain components other than those disclosed. Amendment of the claim replacing the colons with either "comprising" or "consisting of" would overcome this rejection.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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11. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 6-128122 (122) in view of JP 9-194323 (323). See the Thomson Derwent machine translations for citation purposes.

JP '122 is directed to makeup compositions comprising a first layer foundation composition and a second layer finishing composition (summary at page 3). The second layer composition a diffuse reflection powder such as methyl methacrylate, nylon and polyethylene, *inter alia* (sections 0018 to 0019 at page 10) in an amount from 5-100 wt.% (section 0022 bridging pages 11 and 12). For a second layer finishing composition containing spherical nylon powder see sections 0028-0029 at pages 14-15. For a first layer foundation composition containing silicone oil see Example 3 at page 18. The powders disclosed by JP '122 for use in the second layer composition are the same disclosed by Applicant as providing minimized regular reflection and diffuse reflection. See the instant specification at page 51, paragraph 2 for polymethyl methacrylate, polyethylene and nylon powders.

JP '122 does not teach a first layer foundation composition containing a polyether-modified silicone, water and a hydrophobic powder in addition to the silicone oil.

JP '323 teaches a cosmetic composition containing a silicone oil, a polyether modified silicone of the formula instantly claimed, water and hydrophobic powder (page 3). For a makeup foundation composition containing the components instantly claimed see Example 8 at page 22. The compositions of JP '323 provide a light, refreshing feeling upon application without greasiness.


It would have been obvious to one of ordinary skill in the art at the time of the invention to substitute the foundation composition of JP '323 for the first layer foundation composition of JP '122 in order to provide a foundation composition with a light, refreshing feeling without greasiness.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached Monday through Friday between 9:00 am and 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie, can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 or 703-872-9307 for after-final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.


Alysia Berman
Patent Examiner
May 30, 2002


RUSSELL TRAVERS
PRIMARY EXAMINER
GROUP 1200